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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,574	11/17/2003	Mutsuya Kitazawa	30293-64	4721

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EXAMINER

NAGPAUL, JYOTI

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,574

Applicant(s)

KITAZAWA, MUTSUYA

Examiner

Jyoti Nagpaul

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-41, 43-45 and 48-59 is/are rejected.
- 7) ☒ Claim(s) 42, 46 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment filed on October 26, 2006 has been acknowledged. Claims 33-59 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 33-41,43-45,48-52 and 57-59** are rejected under 35 U.S.C. 102(b) as being anticipated by Venooker.

Venooker teaches a valve assembly for fluid delivery which is removably connected to a manifold fitting of an analytical instrument and to a fluid supply for selectively operatively connecting the fluid supply to the analytical instrument/tissue processor. (See Col. 2, Lines 52-56) The assembly comprises of a first longitudinal extending cylindrical ring/coupling means (54) defining an interior area (140). (See Figure 5) The assembly further comprises a longitudinally extending fluid conduit (134) positioned within the interior area (140) and defining a fluid flow aperture. The assembly comprises a laterally extending wall (See Figures 5 and 10-11) between the fluid conduit (144), the laterally extending wall having a top surface (135) directed towards the processing apparatus and defining at least one vent aperture (148) creating fluid venting communication the fluid reservoir (40) and top surface (135). (See Figure 5) Venooker further teaches the fluid conduit (144) provides bi-directional fluid

communication between the fluid container and tissue processor. Venooker teaches, "longitudinal groove 148 is located in the outer surface of the main body portion 132 and intersects the annular groove 146. The longitudinal groove 148 functions as a gas passageway. The coupling means 54 is operatively connected to the complementary manifold fitting 55 fixture of an analytical instrument which is capable of creating a **suction** at the opening 140." (See Col. 9, Lines 53-56) The air vent apertures (148,68) provide fluid venting communication between the reservoir (40) and the processing apparatus/analytical instrument). The apparatus further comprises a second cylindrical ring (50) longitudinally adjacent the first cylindrical ring (54) wherein the first (54) and second cylindrical (50) rings have substantially the same diameter. The first cylindrical ring has a first diameter and the second cylindrical ring has a second diameter. (See Figure 5) The fluid conduit (144) extends through the wall (See Figures 5 and 10-11) within the interior space defined by the first cylindrical ring (54). The fluid conduit (144) extends through the wall and extends within an interior space defined by the second cylindrical ring (50). (See Figure 5) The assembly further comprises a retention cylindrical ring (89) disposed within the second cylindrical ring (50) (See Figure 10) The apparatus further comprises the first cylindrical ring (54) is configured with a corresponding connector/connector fitting (130) on the processing apparatus substantially forming a seal creating an enclosure between the interior of the first ring and the processing apparatus. Venooker teaches, "connector fitting which is generally indicated by the reference numeral 130 is located at the outer end of the housing and a terminal nipple 134 is located at the inner end of the housing. The connector fitting 130

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is adapted to be operatively connected to the complementary manifold fitting 55, see FIGS. 32-34, of aspirating means which forms part of an analytical instrument (not shown)." (See Col. 9, Lines 19-26) The fluid conduit (144) is configured to mate with corresponding fluid conduit of the processing apparatus/analytical instrument.

Venooker further teaches positioning the fluid container assembly adjacent an appropriate locking assembly/tabs (137 and 139). Venooker teaches, "the tabs 137 and 139 are diametrically opposed and extend transversely of the longitudinal axis 127. Alternate positioning and configuration of the tabs of the connector fitting may be accomplished to engage a respective manifold fitting. Tab 137 has an inwardly facing engaging surface 141. One end of the surface 141 has a bevel 143. A flange stop 145 is located at the opposite end of the surface 141 and extends inwardly and transversely of the surface 141. The tab 139 has an inwardly facing engaging surface 147. One end of the surface 147 has a bevel 149. An annular flange 136 extends transversely from the central longitudinal horizontal axis 127 and is located adjacent and spaced from the connector fitting 130. A pair of fingers 144 extends from the flange 136 toward the inner end of the main body portion 132. A longitudinal horizontal bore 138 extends from an outer opening 140 at the fitting 130 through the main body portion 132 and the nipple 134 to an inner opening 142. The bore 138 functions as a liquid passageway. An annular groove 146 is located in the outer surface of the main body portion. A longitudinal groove 148 is located in the outer surface of the main body portion 132 and intersects the annular groove 146. The longitudinal groove 148 functions as a gas passageway. The coupling means 54 is operatively connected to the complementary

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manifold fitting 55 fixture of an analytical instrument which is capable of creating a suction at the opening 140.” (See Col. 9, Lines 30-57) Venooker further teaches a laterally extending barrier (132) between the fluid conduit (144) and first cylindrical ring (54), the barrier having first and second sides. (See Figure 5) The apparatus further comprises at least one vent aperture (148) provided in the barrier (132), the vent aperture creating fluid venting communication between the first side of the barrier and the second side of the barrier within an area defined by the first cylindrical ring (54). (See Figure 5)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 53-56** are rejected under 35 U.S.C. 103(a) as being unpatentable over Venooker in view of Clark.

Refer above for the teachings of Venooker.

Venooker fails to teach the locking assembly and coupler are color coordinated.

Clark discloses method and apparatus for an automated biological reaction system. The method comprises of providing a fluid container assembly including a fluid container having a neck, a coupler/spring attached to the neck and a cap attached to the coupler. Clark recites, "the caps 454, 434 can be spring-biased to the closed position, with the opening pins 472 remaining in contact with the tab lever 454(b), 433, respectively, subsequent to the opening operation as described above to maintain the caps 454, 434 in an open position to allow aspiration of reagents from the reagent container 441 with a pipette probe. Once the pipette probe has been withdrawn from the reagent container 441, the opening pins 472 move in an upward direction away from tabs 454(b), 433 to allow the caps 454, 434 to return to their evaporatively sealed closed positions." (See 176) Then placing the fluid container assembly adjacent to the tissue processor and providing fluid communication between the fluid container and the tissue processor. Clark recites, "pipette probe transfer mechanism can either be located at a remote location or station removed from the cap actuator station 464, thereby requiring movement of a reagent pack 30' to such pipette probe transfer mechanism for access of reagents in a reagent container 441 by the pipette probe." (See 177) The system further positions the fluid container assembly adjacent an appropriate locking assembly. Clark recites, "a reagent pack can be mounted or otherwise positioned on a non-concentric or linear conveyor system, whereby such non-concentric system reciprocates with a reagent pack to facilitate the opening and closing of a capped-closure as described herein." (See 177) Clark further comprises a locking

assembly/cap closure assembly the step of displacing a portion of a locking assembly relative to coupler/spring includes the step of pulling a handle/lever. Clark recites, "the heads of the cap actuator 474 partially lowered to drag along the top of the cap 454 and overcome the force of the internal spring, thereby returning the cap 454 to a partially closed position or the soft seal position with the stopper 454(a) in the opening of the closure 452." (See 174) Clark discloses presently known techniques for container closure systems such as septum caps.

It is well known in the art to include different type of markings, numbers, color codes, or bar codes. It would have been obvious to one of the ordinary skill in this art at the time of the invention by applicant to modify the system of Venooker such that the locking assembly and coupler are color coordinated in order to facilitate the user as to what type of reagent is used at which test sample.

Allowable Subject Matter

6. **Claims 42,46 and 47** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior art fails to teach or fairly suggest the retention cylindrical ring is disposed around the fluid conduit forming a cylindrical gap between the fluid conduit and retention cylindrical ring and a concentric vent ring formed by an outer surface of the fluid conduit and an inner surface of the first concentric ring and the concentric vent ring is in communication with the interior of the tissue processor.

Response to Arguments

7. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JN


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